

REMARKS

I. Status and Disposition of the Claims

In the instant application, claims 1-36, of which claims 1, 7, 12, 16, 21, 24, 26, 30 and 33 are independent, are pending and under consideration on the merits.

In the Office Action¹ mailed April 3, 2008, claims 1-36 were rejected under 35 U.S.C. 103(a) as being unpatentable over Pat. No. US 4,773,009, by Kucera et al. (herein after "*Kucera*") in view of Pat. No. US 7,343,308, by Rojewski et al. (herein after "*Rojewski*");

In this Response to the Office Action, Applicant amends claims 1, 7, 8, 12, 16, 21, 24-27, 29-31, 33, 34 and 36. Support for Amendments can be found at para. 043 of the Specification, "The scoring rules may be determined, for example, using historical data from claims files that have already been processed," and "Each data element is then assigned a score.... For example, rules engine 204 may follow a rule that if a claim file...."

III. Response to Rejections

In this Response to the Office Action, Applicant respectfully traverses the rejection listed above.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

A. The Rejection of the Claims under 35 U.S.C. §103 is Improper.

In the Office Action, claims 1-36 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Kucera* in view of *Rojewski*.

Applicant respectfully traverses the rejections of the claims under 35 U.S.C. §103(a) because a *prima facie* case of obviousness has not been established. "The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I) (emphases in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

The Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007) held that "[t]here is no necessary inconsistency between the idea underlying the TSM [teaching, suggestion, motivation] test and the *Graham* analysis." M.P.E.P. §2141

(rev. 6, Sept. 2007), citing *KSR* at 82 U.S.P.Q. 2d at 1396. Applicant understands this to mean that when applicable, as here, TSM reasoning may still be applied not only by an examiner but also by Applicant to refute a §103 rejection.

Here, a *prima facie* case of obviousness has not been established because the scope and content of the prior art has not been properly determined, nor have the differences between the claimed invention and the prior art been properly ascertained. Accordingly, a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art has not been clearly articulated.

Claims 1-36 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Kucera* in view of *Rojewski*. See Office Action, pages 2. In particular, the Office Action contains the assertion, “one of ordinary skill in the art would have recognized that the results of the combination were predictable.” See Office Action at 3. Applicant respectfully disagrees with the assertion and traverses the rejection for at least the reasons stated below.

As discussed in detail below, a fair reading of *Kucera* and *Rojewski* reveal that the references fail to teach or suggest each and every element of amended claim 1. In addition, no additional evidence has been raised establishing a tenable rationale that one of ordinary skill would have been motivated to modify the references so as to arrive at the claimed invention.

In the present case, amended independent claim 1 recites, *inter alia*, “developing a subrogation potential score for each of the data elements, wherein the developing further comprises calculating the subrogation potential score using a set of rules created from existing historical claim data, or assigning the subrogation potential score using the

set of rules...." *Kucera* does not teach, disclose or suggest this recited feature. The Office Action cites *Kucera*'s col. 3, line 65 to col. 4, line 15 as teaching a system and method to assign a score to each of the data elements. See Office Action at 2. However, nowhere in this citation, or elsewhere in *Kucera*, is there a suggestion of "developing a subrogation potential score for each of the data elements, wherein the developing further comprises calculating the subrogation potential score using a set of rules created from existing historical claim data, or assigning the subrogation potential score using the set of rules....." (Emphasis added) See claim 1. *Kucera*'s col. 3, line 65 to col. 4, line 15 discloses a table that is "a modified Dale-Chall list of words which have been determined on a statistical basis to be the most frequently used words in the English language." It does not disclose a subrogation potential score let alone developing it for each of the data elements. Therefore, *Kucera* does not disclose, teach or suggest, "developing a subrogation potential score for each of the data elements, wherein the developing further comprises calculating the subrogation potential score using a set of rules created from existing historical claim data, or assigning the subrogation potential score using the set of rules," as recited in amended claim 1.

Rojewski fails to cure the deficiencies of *Kucera*. That is, *Rojewski* also fails to teach, disclose or suggest the above-recited feature. *Rojewski*'s system discloses using a probabilistic approach for calculating a score. See *Rojewski* at col. 2, lines 62-63. *Rojewski* scores are derived from algorithms factoring in expected values of multiple characteristics but not necessarily each data element of the insurance claim. See *Rojewski* at col. 3, lines 42-47.

This is contrary to the Applicant's system, in which the insurance subrogation potential scores are developed by determining a set of rules, "Each data element is then assigned a score.... For example, rules engine 204 may follow a rule that if a claim file contains data showing the percentage fault is 100%, indicating that the insured was completely at fault, the percentage fault data element would be given a negative score because this factor would make recovery impossible." See Specification at para. 043. Therefore, unlike the present invention, *Rojewski* does not develop a subrogation potential score for each of the data elements by calculating or assigning a subrogation potential score using a set of rules created from existing historical claim data.

Further, *Rojewski* does not disclose both calculating and assigning subrogation potential scores to develop scores for each of the data elements. The two examples in *Rojewski* disclose either developing a base score based on multiple attributes (Example 1), or calculating a score based on expected values (Example 2). In neither example are subrogation potential scores assigned to a data element. In contrast, as shown in the text cited above, Applicant discloses assigning a subrogation score (as opposed to calculating it) to a data element.

Because neither *Kucera* nor *Rojewski* disclose "developing a subrogation potential score for each of the data elements, wherein the developing further comprises calculating the subrogation potential score using a set of rules created from existing historical claim data, or assigning the subrogation potential score using the set of rules," as recited in amended claim 1, the cited references fail to teach or suggest each and every element of claim 1.

Moreover, one of ordinary skill in the art would not find it obvious to modify the apparatus of *Kucera*, using the teachings of *Rojewski*, to achieve the required combination recited by claim 1. Applicant submits that while examiners may rely upon what is generally known in the art, they **must provide evidentiary proof** of that knowledge. See *In re Zurko*, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001) ("With respect to core factual findings in a determination of patentability . . . the Board cannot simply reach conclusions based on its own understanding or expertise . . . Rather, the Board **must point to some concrete evidence** in the record in support of these findings.") (emphasis is added).

Here, Applicant respectfully submits that the Office Action has not explained *why* or *how* one of ordinary skill would modify the apparatus of *Kucera*, using the teachings of *Rojewski*, so as to arrive at the claimed invention. In particular, the Office Action has not explained at least: (a) *why* one of ordinary skill would modify the steps of *Kucera* so as to extract data elements of the insurance claim related to the insurance claims subrogation potential and develop a subrogation potential score for each of the data elements, wherein the developing further comprises calculating the subrogation potential score using a set of rules created from existing historical claim data, or assigning the subrogation potential score using the set of rules; and, especially, (b) *how* one of ordinary skill would know to select and arrange the steps of *Kucera* and *Rojewski* so as to arrive at a system with the claimed feature of "determining if the insurance claim has subrogation potential based on the subrogation potential scores assigned to each of the data elements", as recited in amended claim 1.

The burden is on the Patent Office to provide some tenable rationale as to *why* and *how* one of ordinary skill in the art would combine *Kucera* and *Rojewski* so as to arrive at the presently claimed methods recited in claim 1. In the present case, however, no such rationale has been provided.

The Office Action contains an assertion that “the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately....” See Office Action at 3. At best, the position taken in the Office Action could be considered an assertion that the proposed modifications could be performed. However, “[t]he mere fact that a reference can be combined or modified does not render the resultant combination [or modification] obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01 (emphasis in original). Combining *Kucera* and *Rojewski* would not result in a predictable variation of the Applicant’s invention because *Kucera* and *Rojewski* lack the elements recited in amended claim 1, namely “developing a subrogation potential score for each of the data elements, wherein the developing further comprises calculating the subrogation potential score using a set of rules created from existing historical claim data, or assigning the subrogation potential score using the set of rules....”

Further, even assuming *arguendo* that the Office Action’s assertion is correct, there is not sufficient motivation for adding to *Rojewski* a such step, since the system in *Rojewski* derives its scores using algorithms. See *Rojewski* at col. 3, lines 42-43. Therefore, it misses the objective of the Applicant’s system as recited in claim 1.

For at least these reasons, Applicant submits that the Office Action has not met the burdens necessary to establish that present claim 1 is obvious under § 103(a). Therefore the § 103(a) rejection of claim 1 is improper, and should be withdrawn.

For at least the reasons noted above, claims 7, 12, 16, 21, 24, 26, 30 and 33 which recite similar elements and were rejected under the same rationale, and claims 2-6, 8-11, 13-15, 17-20, 22-23, 25, 27-29, 31-32 and 34-36 which depend directly or indirectly from claims 1, 7, 12, 16, 21, 24, 26, 30 and 33 are allowable under 35 U.S.C. 103(a). See Office Action at page 3-4.

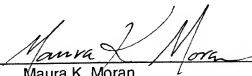
In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 2, 2008

By: 
Maura K. Moran
Reg. No. 31,859